

Application No. 10/687,721
Remarks in Response to Office Action of April 25, 2006

SEP 27 2006

Remarks

Applicants respectfully request reconsideration of the above-identified application in view of the amendments to claims 1, 2, 9-13, 15, and 17-18 in Applicants' RCE and Amendments in Response to the Final Office Action (the "Applicants' Present Response"), and the remarks below. Claims 1-4, 6-8, 10-14 and 17-18 are now pending in this application.

In the Final Office Action, the Examiner rejected Claims 13-15 and 18 under 35 U.S.C. 102(e) as being anticipated by Morrison et al. (U.S. Patent No. 6,522,772). Claims 1-12 were rejected under 35 U.S.C. 103(a) as being unpatentable over Morrison et al. in view of Lapsley et al. (U.S. Pub. No. 2002/0019811). Applicants respectfully traverse each of the rejections.

Applicants' remarks, set forth below, are preceded by related comments of the Examiner set forth in small indented bold-faced type.

Claim Rejections – 35 U.S.C. 102

2. Claims 13-15, 18 are rejected under 35 U.S.C. 102(e) as being anticipated by Morrison et al (U.S. Patent No. 6,522,772).

3. As per claim 13, Morrison et al teach a method for self-checkout of items that are sold on a restricted basis, the method comprising following scanning of an item by a self-checkout customer,...in response to the signal indicating a need for supervisory assistance, initiating an exception process whereby input is received from a store attendant to cause a new database record to be generated, the new database record enabling automated age verification of the customer during subsequent purchase transactions...

6. As per claim 17, Morrison et al teach a method of processing input at a supervisory terminal in a self-checkout system using a handheld supervisory device, the method comprising: at a self-checkout system, generating a supervisory request signal indicating that input of customer biometric data is required to further the processing of a self-checkout transaction by a customer, transmitting the supervisory request signal to a handheld supervisory device, the handheld device comprising a biometric sensor; and at the handheld supervisory device, receiving the supervisory signal, presenting a prompt alerting a user of the handheld device that input of customer biometric data is necessary; receiving customer biometric data at the biometric sensor; and transmitting the biometric data to the self-checkout station (Fig 1, Column 2 lines 44-3 line 18, 8 lines 46-60, and the entire disclosure).

Application No. 10/687,721

Remarks in: Response to Office Action of April 25, 2006

The Examiner's rejection is respectfully traversed. As indicated in Applicants' Response to Office Action Dated August 12, 2005 ("Applicants' 2nd Response"), it is well established that a claim is anticipated only if each and every element as set forth in the claim is found in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Additionally, it is not enough that the cited reference discloses all the claimed elements in isolation, but the reference must disclose each element of the claimed invention "arranged as required by the claim." MPEP § 2131. The cited reference, Morrison et al. simply does not do so.

Claim 13 (and its dependents)

Applicants submit that Morrison et al. does not teach each and every element of the invention as recited by amended claim 13, for at least the following reasons.

Claim 13 discloses, *inter alia*, an exception process that is initiated in response to a failed attempt to purchase a restricted item at a self-checkout station, whereby a signal indicating a need for supervisory assistance is received by a system controller; the controller selects a certain supervisory terminal to handle the request for assistance; and, said selected supervisory terminal is used to create and send a new database record to enable automated age verification by the self-checkout system in subsequent purchase transactions. In contrast, Morrison et al. discloses an exception process whereby the signal received from the self-checkout station merely attracts the attention of store attendants, requiring an attendant in every case to approach the self-checkout station to provide assistance to the store customer. Morrison et al fails to disclose a system controller, a supervisory terminal, an efficient, selective allocation of supervisory tasks to a selected supervisory terminal, or an exception process in which these elements are used. Accordingly, Applicants submit that claim 13 is distinguishable over Morrison et al., and notice to the effect that this claim is in condition for immediate allowance is respectfully requested.

Claim 14 depends from claim 13 and is patentable for at least the same reasons stated with respect to claim 13.

SEP 27 2006

Application No. 10/687,721

Remarks in Response to Office Action of April 25, 2006

Claim 17 (and its dependent)

As quoted above, in the Final Office Action the Examiner cites figure 1, col. 2 line 44 through col. 3 line 18, col. 8 lines 46-60, and the entire Morrison disclosure. The Examiner contends that Morrison et al. discloses a method of processing input during a self-checkout procedure employing, *inter alia*, a handheld supervisory device, generation and transmission of a supervisory request signal to a handheld supervisory device that comprises a biometric sensor, generation of biometric data at the supervisory device and transmission of such data to a self-checkout station. The Examiner's contention and rejection of claim 17 is respectfully traversed.

As noted above, when rejecting a claim based on 35 U.S.C. 102, the Examiner must show that each and every element is found in the single cited reference as set forth in the rejected claim. MPEP § 2131. In addition, when making a final rejection, all outstanding grounds of rejection must be carefully reviewed and fully developed by the Examiner prior to making such rejection. MPEP § 706.07. Finally, when the applicant traverses any rejection, the Examiner should take note of the applicant's argument and answer the substance of it. MPEP § 707.07 (f).

Contrary to the Examiner's contention, Morrison et al. does not disclose, in any of the places cited by the Examiner or anywhere in the Morrison disclosure, a handheld supervisory device that comprises a biometric sensor, the use of such supervisory device to receive a supervisory request signal, or the transmission of biometric data to and from such handheld supervisory device. Specifically, (i) Morrison et al does not disclose any handheld supervisory device or any other supervisory device that is used to remotely supervise self-checkout transactions; (ii) the supervisory request signal of Morrison et al. is limited in content and merely attracts the attention of store personnel without providing detailed information on the supervisory request, thereby requiring a store attendant to approach the self-checkout station in each case and regardless of the nature of the request for assistance (col. 14 lines 1-27); and (iii) the supervisory request signal in Morrison et al. is not transmitted to a handheld supervisory device that is equipped to receive, process, and transmit biometric data.

In addition, in the Applicants' Present Response Applicants further amended claim 17 in an effort to place this application in condition for immediate allowance. As amended, it is submitted that claim 17 is now distinguishable from Morrison et al. in additional respects,

Application No. 10/687,721

Remarks in Response to Office Action of April 25, 2006

including, *inter alia*, the efficient, selective transmittal of supervisory request signals in the disclosed self-checkout system using a system controller, wherein the signal is transmitted to a selected handheld terminal to facilitate an efficient handling of requests for supervisory intervention.

Claim 18 depends from independent claim 17 and is patentable for at least the reasons noted above. Accordingly, Applicants submit that claims 17 and 18 are patentable for the reasons noted above, and notice to the effect that these claims are in condition for immediate allowance is respectfully requested.

As an additional matter, it seems that the Examiner did not fully develop, in the Final Office Action, the traverses made by the Applicants in Applicants' 2nd Response with respect to claim 17. Specifically, paragraph 8 in the office action dated August 12, 2005 (the "2nd Office Action") and paragraph 6 in the Final Office Action provide identical grounds for rejection of claim 17, and the Examiner has not further developed or responded, in the Final Office Action, to traverses made in Applicants' 2nd Response regarding the element of transmitting biometric data from a handheld supervisory device to a self-checkout station as recited by claim 17. Further, it is respectfully contended by Applicants that, notwithstanding the insufficient response to Applicants' traverses as detailed above, Morrison et al. does not disclose any handheld supervisory terminal as contended by the Examiner in both the Present and the 2nd Office Actions. It is therefore submitted that in the Final Office Action fails to fully develop the grounds for rejection and respond to Applicants' traverses as required by MPEP § 706.07 and MPEP § 707.07(f). Accordingly, it is respectfully requested that the Examiner withdraw the Final Office Action as being a deficient response to Applicants' 2nd Response under the MPEP.

Claim Rejections – 35 U.S.C. 103

10. As per claim 1, Morrison et al teach a self-checkout system comprising: a self-checkout station configured for customer-operated self-checkout of items for purchase; and a controller operatively coupled to the mobile terminal and to the self-checkout station, the controller being configured to send data over a wireless network to the mobile terminal instructing the mobile terminal to initiate a biometric data capture operation, the biometric data capture operation being related to a self-checkout transaction (*fig 1, column 2 lines 44-3 line 18, 8 lines 46-60, and the entire disclosure*). Morrison et al fail to teach a mobile data terminal comprising a wireless network interface and a biometric data sensor. However, Lapsley et al teach a mobile data terminal comprising a wireless network interface

Application No. 10/687,721

Remarks in Response to Office Action of April 25, 2006

and a biometric data sensor (*see paragraph 0040, 0041*). Therefore, it would have been obvious to one of ordinary skill in the art a [sic] the time the invention was made to modify the inventive concept of Morrison et al to include Lapsley et al's mobile data terminal comprising a wireless network

The undersigned has reviewed the above-indicated rejections in the Final Office Action and respectfully traverses these rejections for reasons set forth herein.

To establish a case of obviousness, the Examiner must meet three basic criteria. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine the references' teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not be based on the applicant's disclosure. MPEP 706.02(j), citing *In re Vaack*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Thus, in order for the Examiner to establish a case of obviousness, he or she must (i) demonstrate that the prior art references describe or suggest all the claimed limitations of the present invention, and (ii) show a motivation to modify or combine the references without resort to hindsight. The Examiner has done neither.

Contrary to the Examiner's contention, Morrison et al. does not teach or suggest, in the places cited by the Examiner or anywhere else in Morrison et al.'s disclosure, a system controller, a mobile data terminal, or an operative coupling between such a controller, a mobile terminal and a self-checkout station. For this reason, Morrison et al. also does not teach or suggest a controller that is configured to send data over a wireless network to a mobile terminal, instructing the terminal to initiate biometric data capture operation. Instead, Morrison et al. simply discloses a processing unit 26 that is coupled to a memory device 27 and to a network 25, wherein the processing unit processes data received during a self-checkout process, communicates with memory device 27, and also communicates with network 25 through a wire or wireless interface. Morrison et al., col. 8 lines 46-60. Processing unit 26 is not intended to, and does not, control the operation of a mobile data terminal or instructs such terminal to initiate a biometric data capture operation, neither generally nor in the context of the mobile nature of

Application No. 10/687,721

Remarks in Response to Office Action of April 25, 2006

such mobile data terminal. Morrison et al. col. 6 lines 31-37. Similarly, Morrison et al.'s network 25 cannot be considered a mobile or wireless data terminal.

Further contrary to the Examiner's contention, Lapsley et al. does not teach or suggest any mobile data terminal that is designed to initiate and control, operatively with a system controller, the process of a biometric data capture operation. Instead, lapsley et al. simply discloses, in one implementation, a telephone that may be used to transmit certain biomertic data – with no ability to exercise any control on, or monitor, the device to which such data is transmitted. In fact, nowhere in lapsley et al. is the idea of a data terminal even suggested, and the wireless “access device” in Lapsley et al. is one of several optional access devices that may be used by a purchaser to complete a financial transaction, wherein in each case the access device only needs to have the ability to establish a line of communication. Lapsley et al. paragraphs 37-41.

In contrast, and as further disclosed in claim 1 as amended, the present invention claims, *inter alia*, a plurality of supervisory data terminals – of which at least one is a mobile terminal operating on a wireless network interface and having a biometric data sensor, designed to monitor and supervise self-checkout transactions in a self-checkout system; and a controller coupled to said supervisory terminals and configured to control and administer the coordinated operation of said terminals.

Applicants submit that neither Morrison et al. nor Lapsley et al. teach or suggest, alone or in combination, a system controller, mobile supervisory terminals, supervising a self-checkout system by combining a plurality of supervisory terminals with a system controller, or administration of such supervising activity, as disclosed in the present invention. MPEP § 706.02(j) (“the prior art reference (or references when combined) must teach or suggest all the claim limitations”).

In addition, to establish a *prima facie* case of obviousness, there must be some teaching, suggestion or incentive to combine the references and make the modifications proposed by the Examiner. *In re Fritch*, 972 F.2d 1260, 1265 (Fed. Cir. 1992); MPEP § 2143. Such claim of obviousness has to consider the claimed invention and references as a whole, and motivation and reasonable expectation of success must be evaluated without impermissible hindsight. MPEP §

Application No. 10/687,721

Remarks in Response to Office Action of April 25, 2006

2141 (c)(III). It is respectfully submitted that the combination of Lapsley et al.'s access device and Morrison et al.'s self-checkout system could not be reasonably combined into a self-checkout system as set forth in claim 1 of this invention without resorting to impermissible hindsight. The combined references neither teach nor suggest the combined operation of multiple supervisory wireless or wire terminals, or the control and operation of such terminals by system controller. In fact, and as noted above, the cited references do not even teach or suggest the existence of such supervisory terminals or controller.

For at least the reasons that the cited references do not teach or suggest the elements of a system controller, supervisory data terminals, or the coordinated operation of such terminals, it is respectfully submitted that the Examiner's rejection of claim 1 (and its dependent claims) under 35 U.S.C 103 is improper. Accordingly, notice to the effect that independent claim 1 and dependent claims 2-12, as amended, are in condition for immediate allowance is respectfully requested.

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SEP 27 2006

Application No. 10/687,721
Remarks in Response to Office Action of April 25, 2006

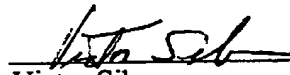
Conclusion

By the herein presented Remarks and Amendments to claims as presented in Applicants RCE and Amendments, Applicants have made diligent efforts to place this application in condition for allowance. Notice to this effect is respectfully solicited.

If there remain any questions regarding the present application, or if the Examiner has any further suggestions for expediting allowance of the present application, the Examiner is cordially requested to contact the undersigned to enable the undersigned to arrange for an interview with the Examiner.

Respectfully submitted,

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